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APPLICATION NO. 09/266,155	FILING DATE 03/10/99	PRICE B	FIRST NAMED INVENTOR B	ATTORNEY DOCKET NO. AS
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EXAMINER JUSKA, C
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ART UNIT 1771	PAPER NUMBER 3
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DATE MAILED: 10/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/266,155

Applicant(s)

Price et al.

Examiner  
Cheryl Juska

Group Art Unit  
1771



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-6 is/are pending in the application

Of the above, claim(s) 1 and 4 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 2, 3, 5, and 6 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3 & 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 4, drawn to processes for manufacturing a sound insulating structure, classified in class 156, subclass 242.
  - II. Claims 2, 3, 5, and 6, drawn to a laminar assembly, a vehicle sound insulating structure, and a vehicle carpet assembly, classified in class 428, subclass 95.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the permeable laminated product can be made by a different method, such as by making perforations in said laminate.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Glenn Messina on August 3, 2000, a provisional election was made without traverse to prosecute the invention of Group II, claims 2, 3, 5, and 6.

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Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 and 4 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Drawings***

6. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2, 3, 5, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 2, 3, 5, and 6 are indefinite due to the lack of a positive limitation to the distinguishing structural or compositional feature of the claimed article. Claim 2, 3, and 5 are written in a Jepson format, wherein the only claim limitation recited over the known prior art is the physical property of "post formation permeability." With regard to claim 6, which is not in a Jepson format, the only non-preamble, positive limitation is to the "post formation permeability." Thus, it is unclear what the distinguishing structural or compositional feature is recited. *Ex parte Slob*, 157 USPQ 172 states the following:

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics; thus, expression "a liquefiable substance having a liquefaction temperature from about 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended.—*Ex parte Slob* (PO BdApp) 157 USPQ 172.

9. Claims 2, 3, and 5 are indefinite for the use of the phrase "of a type." Said phrase renders the claims indefinite because the claims includes elements not actually disclosed (those encompassed by "of a type"), thereby rendering the scope of the claims unascertainable.

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***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 2, 3, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by the admitted prior art.

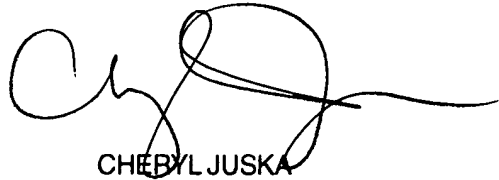
Claims 2, 3, and 5 are independent claims written in a Jepson format. Thus, the preamble of each claim constitutes admitted prior art. The recited improvement in each claim is that the article has a "post formation permeability of 500 rayls or less as measured by concentric airflow resistance equipment." However, it is asserted that the prior art structures admittedly meet the presently claimed structural and compositional features, and as such, said prior art must inherently meet the claimed property limitation. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594.

With regard to claim 6, it is noted that said claim is not written in a Jepson format. However, said claim recites structural limitations which are admitted as prior art in claim 3. Therefore, claim 6 is also rejected based upon the inherency argument presented above.

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*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached at (703) 308-2414. Fax numbers for this Group are (703) 305-3601 and (703) 305-7718.



CHERYL JUSKA  
PATENT EXAMINER

cj

October 10, 2000